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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMIT RAIKAR and GURUPRASAD RAMARAO

Appeal 2009-009302
Application 10/632,446
Technology Center 2400

Before MARC S. HOFF, CARLA M. KRIVAK, and
BRADLEY W. BAUMEISTER, Administrative Patent Judges.

KRIVAK, Administrative Patent Judge.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and enter a new ground of rejection under 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Appellants' claimed invention relates to configuring application and network management systems for providing security to devices and/or applications associated with networks (Spec. 1:13-16).

Independent claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for configuring templates, the method comprising:

configuring a template for an application and network management system with first information for determining whether data associated with at least one message received by the template should or should not be processed by the template;

configuring the template with second information for processing the data associated with at least one of the received messages; and

configuring the template with third information for preventing the communication of at least one received message to other templates of the application and network management system.

REFERENCES

The Examiner rejected claims 1-7 and 14-19 under 35 U.S.C. § 102(e) based upon the teachings of Desai (US 2003/0188189 A1).

The Examiner rejected claims 8-13 under 35 U.S.C. § 103(a) based upon the teachings of Desai and Flowers (US 6,957,348 B1).

ANALYSIS

Claims 1-7

The Examiner finds Desai teaches all the features of Appellants' claims 1-7 and 14-19. Appellants address this rejection with respect to claim 1 and contend Desai does not teach multiple steps when analyzing a message, as Desai teaches filtering processes that are part of a log-based event classification system and a network/host based intrusion detection system (App. Br. 10, 15, 17; Reply Br. 5). Appellants further assert Desai's templates/filters are applied to data after it has been collected, parsed, normalized, and categorized for streamlining a diagnosis (App. Br. 12; Reply Br. 6). That is, Desai teaches filters that first statistically qualify the data and "then compare the findings." In contrast, Appellants assert claim 1 teaches "'configuring the template with third information for preventing the communication of at least one received message to other templates of the application and network management system'" (App. Br. 12, 17). Additionally, the filter processing in Desai "resides in two different parts of Desai's system," not as a single template (Reply Br. 8).

We agree with the extensive arguments Appellants have provided as to the differences between Desai and the claimed invention. Thus, Desai does not anticipate claims 1, and claims 2-7, which depend therefrom.

Claims 14-19

Appellants argue that claim 14, as well as dependent claims 15-19, is patentable for similar reasons as raised with respect to claim 1 (App. Br. 18). We disagree.

Claim 14 recites a computer system comprising a memory unit and a processor coupled to the memory unit. Claim 14 further recites "wherein the

processor executes instructions associated with a template automator, and wherein the instructions of the template automator are for: configuring a template [with three types of information].” That is, claim 14 affirmatively recites only the memory unit and the processor. It does not affirmatively recite the template automator or the instructions associated with the template automator that the processor is to execute. Rather, the claim language that inferentially references the automator and the associated instructions constitutes functional language describing the activity (instruction execution) that the processor is able to perform.

Thus, claim 14 reads on any general purpose computer that includes a memory and a processor, as long as the processor is capable of executing the instructions as claimed. Because Desai discloses a computer network (e.g., Fig. 1), Desai discloses all of the affirmatively recited elements of claim 14: a memory and a processor. Moreover, because the precise purpose of a processor is to execute computer instructions, Desai’s computer system would be capable of executing the instructions claimed. Therefore, claim 14 and claims 15-19, which depend therefrom, are anticipated by the general prior art.

NEW GROUNDS OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter new grounds of rejection for claims 1-13.

Claim 1

Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. 35 U.S.C. § 101 permits patents to be issued for a “new and useful process, machine, manufacture, or composition of matter.”

Claim 1 does not fit into one of these four categories of invention. Claim 1 is directed to a method for configuring templates with information.

Restated, claim 1 is directed to a method of writing computer code or software. The claimed method does not tie this software to any particular machine or transform any article into a different state or thing. In re Bilski, 545 F.3d 943, 961 (Fed. Cir. 2008) (en banc), *aff'd sub nom. Bilski v. Kappos*, 129 SCt 2735 (U.S. 2010). See also, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); Subject Matter Eligibility of Computer Readable Media.

Although claim 1 is rejected under 37 C.F.R. § 41.50(b), claims 2-7 have not been reviewed to the extent necessary to determine whether these claims are unpatentable under 35 U.S.C. §101. We leave it to the Examiner to determine the appropriateness of any further rejections based thereon.

Claims 8-13

Claims 8-13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The preamble of claim 8 indicates it is directed to a method for providing a guideline for creating templates; however the body of the claim only sets forth the purpose of the information contained within the guideline. Claim 8 does not set forth any method steps for providing the guideline. As such, one cannot reasonably ascertain whether claim 8 is intended to be directed to a method for providing a guideline for creating templates, a method for creating templates, some communication process that employs the templates, or the templates themselves.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety*

Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). “[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential), available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd073300.pdf>.

Claims 9-13, which depend from claim 8, do not clarify the ambiguities associated with claim 8 and, as such, are rejected under the same rationale.

Because the metes and bounds of claim 8-13 cannot be reasonably ascertained, we do not address the merits of the Examiner’s obviousness rejection under 35 U.S.C. § 103(a) over Desai in view of Flowers. See *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292 (CCPA 1962) (holding that the examiner and the board were wrong in relying on what at best were speculative assumptions as to the meaning of the claims and basing a prior-art rejection thereon.)

DECISION

The Examiner’s decision rejecting claims 1-7 is reversed.

The Examiner’s decision rejecting claims 14-19 is affirmed.

New grounds of rejection for claims 1-13 are entered.

TIME PERIOD

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2010).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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